



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231  
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/504,803      | 02/16/2000  | P. Howard Edelstein  | 01985-P0040A        | 6146             |

7590 09/23/2002

Wesley W. Whitmyer, Jr.  
St Onge Steward Johnston & Reens LLC  
986 Bedford Street  
Stamford, CT 06905-5619

EXAMINER

FELTEN, DANIEL S

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

3624

DATE MAILED: 09/23/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/504,803

Applicant(s)

Edelstein et al

Examiner

Daniel Felten

Art Unit

3624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on May 28, 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-53 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-53 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some\* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_ 6) ☐ Other:

## DETAILED ACTION

1  
2 1. Receipt of the amendment filed May 28, 2002 amending claims 1, 11, 23 and 39 are  
3 acknowledged. Claims 1-53 are pending in the application and are presented to be examined  
4 upon their merits.

### *Response to Arguments*

5  
6  
7  
8 2. Applicant's arguments filed May 28, 2002 have been fully considered but they are not  
9 persuasive. Please note the additional citations from the Hawkins et al reference along with the  
10 additional comments made.

### *Claim Rejections - 35 USC § 102*

11  
12  
13  
14 3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form  
15 the basis for the rejections under this section made in this Office action:

16 A person shall be entitled to a patent unless --

17 (e) the invention was described in a patent granted on an application for patent by another filed in the United  
18 States before the invention thereof by the applicant for patent, or on an international application by another  
19 who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371 of this title before the  
20 invention thereof by the applicant for patent.

1 4. Claims 1-53 are rejected under 35 U.S.C. 102(e) as being anticipated by Hawkins et al  
2 (hereinafter "Hawkins", US 6,029,146).

3 **As in claims 1, 3-6, 23, 34, 38, 41 and 42:**

4 Hawkins discloses a system for facilitating the processing and management of a securities trade  
5 (see Hawkins, Abstract) comprising:

6 A computer (see Hawkins, col. 3, ll. 51-54);

7 trade execution information received by the computer, said trade execution information  
8 indicative of an executed trade by a first trading party (*executing broker*) and comprising trade  
9 data concerning one or more details of the executed trade itself (see Hawkins, col. 3, ll. 61-64;  
10 and figs. 12 and 13, col. 14, ll. 11+);

11 trade allocation information received by the computer, the trade allocation information  
12 indicative of an ordered trade by a second trading party (*originating broker*) and comprising  
13 trade data concerning one or more details of the ordered trade itself (see Hawkins, col. 3, ll. 61-  
14 64; and fig. 11, col. 13, ll. 31+);

15 a set of predefined acceptable trade parameters/profiles (see Hawkins, col. 4, ll. 10+);

16 and

17 software executing on the computer for comparing the trade data contained in said  
18 execution information with the trade data contained in the trade allocation information, and for  
19 determining that a match exists if the trade data contained in execution information and the trade  
20 data contained in the trade allocation information correlate within the set of predefined

1 acceptable trade parameters (see Hawkins, col. 3 , ll. 64 to col. 4, ll. 47; and col. 11, ll. 23+;  
2 and col. 14, ll. 11+ ).  
3

4 **As in claim 2:**

5 Wherein the set of predefined acceptable trade parameters is dependent of the identities of the  
6 first trading party and the second trading parties (see Hawkins, figs. 8-10; col. 12, line 19 to  
7 col. 13, line 28).  
8

9 **As in claim 7, 29:**

10 wherein if a match is not found to exist, software executing on the computer generates and  
11 transmits an exception notification to the first trading party and the second trading party  
12 informing them that an exception has been detected, and further comprising software executing  
13 on the computer for receiving an instruction for exception processing from at least one of the  
14 first trading party and second trading party, and for processing the exception according to the  
15 instruction for exception processing (see Hawkins, col. 3, lines 48+).  
16

17 **As in claim 8, 30:**

18 the instruction for exception processing comprises instruction to reject the match, and wherein  
19 the system terminates processing of the trade (see Hawkins, col. 3, lines 48+).  
20

1   **As in claim 9, 31:**

2   the instruction for exception processing comprises an instruction to force the match, and  
3   wherein the system continues processing the trade (see Hawkins, col. 3, lines 48+).

4  
5   **As in claim 10, 32:**

6   the instruction for exception processing comprises an instruction to modify at least one of the  
7   trade execution information and the trade allocation information and wherein the system  
8   continues processing the trade (see Hawkins, col. 3, lines 48+).

9  
10   **As in claim 11, 39:**

11   wherein the trade data contained in the trade execution information and the trade data contained  
12   in the trade allocation information including minimum pairing data;

13       further comprising software executing on said computer for comparing the trade data  
14   contained in the trade execution information with the trade data contained in the trade  
15   allocation information, the software determining that a paring exists if the minimum pairing  
16   data pairing data of the trade data contained in said trade execution information corresponds to  
17   the minimum pairing data of the trade data contained in said trading execution information  
18   corresponds to the minimum pairing data of the trading allocation information; and

1            wherein the matching software compares trade execution information and trade  
2 allocation information only after a pairing has been found to exist (see Hawkins, col. 3, lines  
3 48+; and col. 14, 11+).

4  
5    **As in Claim 12, 33:**

6 the minimum pairing data comprises an indicator of whether shares are being bought or sold,  
7 an indicator of a trade date, a security identification, and an indicator of the number of shares  
8 traded (see Hawkins, col. 3, lines 48+).

9  
10  
11  
12    **As in Claim 13, 40:**

13 an affirmation generated by the computer if a match is determined to exist, the affirmation  
14 being transmitted to the first trading party and the second trading party confirming that a match  
15 has been detected by matching software and containing all data necessary for settling the trade  
16 (see Hawkins, col. 3, lines 48+).

17  
18    **As in claims 14-18, 24, 35, 43-45:**

19 having a plurality of enrichment databases having enrichment data stored thereon (see  
20 Hawkins, fig. 18, col. 15, line 51 to col. 16, line 6).

1  
2 **As in claim 19, 25:**

3 allowing the first trading party and second trading party to access the trade status database in  
4 order to view the real-time status of the trade (see Hawkins, col. 8, lines 1-10 ).  
5

6 **As in claim 20, 36 and 37:**

7 wherein first trading party is a broker and wherein the trade execution information is extracted  
8 from an order execution notice received by the computer (see Hawkins, col. 3, line 48 to col.  
9 4, line 3; and col. 7, line 47+).  
10

11 **As in claims 21, 22, 46-48:**

12 ...Extracting the trade execution information from an order execution notice;...extracting trade  
13 allocation information from an allocation;...translating the trade execution information and  
14 trade allocation into a usable format (see Hawkins, col. 3, line 48 to col. 4, line 3).  
15

16 **As in claims 49-53:**

17 ...transmitting exception notification (see Hawkins, col. 3, line 48 to col. 4, line 3).  
18  
19  
20



1

2 *Additional Comments*

3

4 5. The Examiner has included additional citation within the Hawkins et al reference which  
5 addresses the new claim language presented in the amendment. In general, Hawkins et al  
6 teaches a broker to broker Matching electronic trading confirmation system which confirms  
7 and settles trade orders placed remotely between brokers. In particular, the examiner has  
8 pointed out the features in Hawkins et al comprising trade data concerning one or more details  
9 of the executed trade itself (see figs. 12 and 13) and further matching features found in the  
10 patent that would render applicant's claim(s) obvious to one of ordinary skill in the art.

11

12 *Conclusion*

13 6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time  
14 policy as set forth in 37 CFR 1.136(a).

15 A shortened statutory period for reply to this final action is set to expire THREE  
16 MONTHS from the mailing date of this action. In the event a first reply is filed within TWO  
17 MONTHS of the mailing date of this final action and the advisory action is not mailed until after  
18 the end of the THREE-MONTH shortened statutory period, then the shortened statutory period  
19 will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR  
20 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however,  
21 will the statutory period for reply expire later than SIX MONTHS from the mailing date of this  
22 final action.

1 7. Any inquiry concerning this communication or earlier communications from the examiner  
2 should be directed to **Daniel S. Felten** whose telephone number is (703) 305-0724. The  
3 examiner can normally be reached between the hours of 7:00AM to 5:30PM Monday-Thursday.  
4 Any inquiry of a general nature relating to the status of this application or its proceedings should  
5 be directed to the Customer Service Office (703) 306-5631, or the examiner's supervisor  
6 **Vincent Millin** whose telephone number is (703) 308-1065.

7  
8 8. Response to this action should be mailed to:

9 Commissioner of Patents and Trademarks

10 Washington, D.C. 20231

11 for formal communications intended for entry, or (703) 305-0040, for informal or draft  
12 communications, please label "Proposed" or "Draft".

13 Communications via Internet e-mail regarding this application, other than those under 35  
14 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be  
15 addressed to [daniel.felten@uspto.gov].

16 All Internet e-mail communications will be made of record in the application file. PTO  
17 employees do not engage in Internet communications where there exists a possibility that  
18 sensitive information could be identified or exchanged unless the record includes a properly  
19 signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly  
20 set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and  
21 Trademark on February 25, 1997 at 1 195 OG 89.

22  
23 

24 DSF

25 March 19, 2002

  
VINCENT MILLIN  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3600